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09/717,729	11/21/2000	Michael D. Ellis	UV/168	6773
1473	7590	07/29/2004	EXAMINER	
FISH & NEAVE 1251 AVENUE OF THE AMERICAS 50TH FLOOR NEW YORK, NY 10020-1105			BELIVEAU, SCOTT E	
			ART UNIT	PAPER NUMBER
			2614	

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9

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/717,729

Applicant(s)

ELLIS, MICHAEL D.

Examiner

Scott Beliveau

Art Unit

2614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 June 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

**DETAILED ACTION*****Priority***

1. Applicant's claim for domestic priority under 35 U.S.C. 119(e) is acknowledged.

However, the provisional application upon which priority is claimed fails to provide adequate support under 35 U.S.C. 112 for claims 1-32 of this application. With respect to claims 1 and 17, the provisional application discloses "creating a message having associated criteria at a first location" such that the messages with targeting criteria or unique identifiers may be generated via the service provider and subsequently "distributed . . . from the first location to a second location" (PA: Page 2, Lines 21 – Page 3, Line 2). Arguably some sort of "comparison" subsequently takes place given that only users authorized for the targeting criteria (ex. channel source ID) receive the message, presuming that "second location" actually stores the "user information" associated with the particular authorizations. The storage of the "user information", however, is not clearly set forth in the provisional application, as the section relied upon for the "user information" is not disclosed as being particularly associated or stored at either the "first" or "second location". The provisional application, however, is completely silent as to the negative limitation "wherein the comparing the targeting criteria is not in response to a request for the message". It is unclear if the service provider is sending a message in response to a request or if it is pushing messages set-top terminals absent a request. As there is no positive recitation of the comparing being performed both in response to and not in response to a request, there is no basis for excluding the alternative. Furthermore, there is no clear disclosure of "presenting the message to the user when the targeting criteria are satisfied".

With respect to claims 6 and 22, the provisional application fails to disclose the limitation of “presenting the message using a digital video recorder”.

With respect to claims 7, 9-13, 23, and 25-29, the provisional application fails to disclose the limitations for conducting a comparison based upon stored user information relating to a “reminder”, to a “service”, to a “favorite setting”, to a “parental control”. Furthermore, the provisional application fails to disclose the limitations relating to using the “interactive television application to select content for recording”, to “order a product”, or to “order a service”. The provisional application only sets forth an example of using messaging based on a comparison if the user is authorized to view a particular channel.

With respect to claims 14 and 30, the provisional application fails to disclose the limitation of “comparing the targeting criterion to stored user information that a television service provider has set”.

### *Drawings*

2. The drawings were received on 2 June 2004. These drawings are approved.

### *Response to Arguments*

3. Applicant's arguments with respect to claims 1-32 have been considered but are moot in view of the new ground(s) of rejection.

With respect to the newly added limitation of the “comparing” step is performed “not in response to a request for the message”, the applicant's arguments are not persuasive in light of the Alexander et al. reference. In particular, the comparison process of Alexander et al. is

Art Unit: 2614

not performed “in response to a request for the message”, but is rather performed in response to the user based request or activation of the EPG and related functionality. Similarly, such a process is conducted “in response to receiving the message” given that the message needs to have been received prior to a comparison being made (Col 34, Lines 10-25).

*Claim Rejections - 35 USC § 112*

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1-32 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The examiner is unclear as to where support is found for the newly added negative limitation “wherein the comparing the targeting criteria is not in response to a request for the message”. In particular, the specification positively recites that messages are created and sent from the service provider and are subsequently filtered by the set-top terminal. However, it is unclear from the specification that these messages are necessarily not being sent in response to a previous request for the message (ex. an application requests new advertisements, a user requests to be notified of an upcoming program, promotion, etc.) as opposed to being generated and/or pushed based purely at the discretion of the service provider. The specification is simply silent as to the nature of a “request”.

Art Unit: 2614

Any negative limitation or exclusionary proviso must have basis in the original disclosure. If alternative elements are positively recited in the specification, they may be explicitly excluded in the claims. See *In re Johnson*, 558 F.2d 1008, 1019, 194 USPQ 187, 196 (CCPA 1977) (“[the] specification, having described the whole, necessarily described the part remaining.”). See also *Ex parte Grasselli*, 231 USPQ 393 (Bd. App. 1983), *aff’d* mem., 738 F.2d 453 (Fed. Cir. 1984). The mere absence of a positive recitation is not a basis for an exclusion. Any claim containing a negative limitation which does not have basis in the original disclosure should be rejected under 35 U.S.C. 112, first paragraph as failing to comply with the written description requirement. See MPEP 2173.05(i).

### *Claim Rejections - 35 USC § 102*

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1, 2, 5, 15-19, 21, 31, and 32 are rejected under 35 U.S.C. 102(e) as being anticipated by Siedman et al. (US Pat No. 6,298,482).

In consideration of claims 1 and 17, the Siedman et al. reference discloses a system and method for providing a “targeted message” to a plurality of users in order to “implement an interactive television application” (Col 3, Lines 11-15). The method involves a “first

Art Unit: 2614

processor” or head-end residing at a “first location” that “creates a message” with “associated targeting criteria” [25] which are subsequently “distributed . . . from the first location to a second location”. Upon receipt of the “message” the user receiver, or “second processor” [1], “compares the targeting criteria to user information” [82] “in response to receiving the message from the first location, wherein the comparing the targeting criteria is not in response to a request for the message” but is based merely upon the receipt of the message. Upon satisfying the “targeting criterion”, the “message” is “presented” [31] (Figures 2A/B; Col 7, Lines 25-33).

Claims 2, 15, 16, 18, 31 and 32 are rejected wherein the “message” is “created . . . [by] an interactive television application provider” or “television service provider” and is “distributed . . . through a television distribution facility” such as the cable provider headend (Col 4, Lines 31-48).

Claims 5 and 21 are rejected wherein the “message” is “presented . . . using a set-top box” [1].

8. Claims 1, 2, 5, 15-19, 21, 31, and 32 are rejected under 35 U.S.C. 102(a) as being anticipated by Maillard et al. (EP 0963119 A1).

In consideration of claims 1 and 17, the Maillard et al. reference discloses a system and method for “providing a targeted message to a user that is used to implement an interactive television application”. The system involves “creating a message having associated targeting criteria at a first location” or service provider that is subsequently “distributed along with the targeting criteria” from the “first location” or service provider to a “second location” or interactive terminal [160] (Figures 1-3; Paras. [0024] – [0027], [0038], [0052], [0076 –

Art Unit: 2614

0084]). As illustrated in Figure 2, the system “compares the targeting criteria to user information stored at the second location in response to receiving the message from the first location, wherein the comparing the targeting criteria is not in response to a request for the message”. Rather, the “comparison” is performed as a result of the receipt of the message and the “message” is “presented . . . to the user when the targeting criteria are satisfied” (Paras. [0051 – 0055]).

Claims 2, 15, 16, 18, 31 and 32 are rejected wherein the “message” is “created . . . [by] an interactive television application provider” or “television service provider” [170/150] and is “distributed . . . through a television distribution facility” [120].

Claims 5 and 21 are rejected wherein the “message” is “presented . . . using a set-top box” [160].

9. Claims 1-7, 11, 14-23, 27, and 30-32 are rejected under 35 U.S.C. 102(e) as being anticipated by Alexander et al. (US Pat No. 6,177,931).

In consideration of claims 1 and 17, the Alexander et al. reference discloses a system and method for providing a “targeted message” such as an advertisement to a plurality of users in order to “implement an interactive television application” or electronic program guide (EPG) (Figure 1). The method involves a “first processor” such as an advertising distributor residing at a “first location” that “creates a message” or advertisement having “associated targeting criteria” including theme codes, profile codes and other selection intelligence which are subsequently “distributed along with the targeting criteria from the first location to a second location” (Col 34, Lines 10-25). Upon receipt of the “message” the user receiver, or “second processor”, “compares the targeting criteria to user information . . . in response to



Art Unit: 2614

receiving the message from the first location, wherein the comparing the targeting criteria is not in response to a request for the message” associated with the viewer profile which among other things describes/stores the user’s interactions with the EPG and upon satisfying the “targeting criterion”, the “message” or advertisement is presented (Col 32, Line 23 – Col 35, Line 37).

Claims 2-4 and 18-20 are rejected wherein the “message” or advertisements may be distributed via the “Internet” and/or via a “television distribution facility” (Col 34, Lines 10-25).

Claims 5, 6, 21, and 22 are rejected wherein the message is “presented” via a “set-top box” or via a “digital video recorder” (Col 3, Lines 1-7).

Claims 7 and 23 are rejected wherein the user is operable to “use the interactive television application to set a reminder based upon user input” (Col 9, Line 65 – Col 10, Line 29) and may further “compare the targeting criterion to stored user information relating to the reminder” in conjunction with the selection of an advertisement (Col 35, Lines 14-17).

Claims 11 and 27 are rejected wherein the user is operable to “use the interactive television application to select content for recording” (Col 10, Line 61 – Col 11, Line 7) and may further “compare the targeting criteria to stored user information relating to the content” in conjunction with the selection of an advertisement (Col 35, Lines 14-17).

In consideration of claims 14 and 30, the embodiment may further “compare the targeting criteria to stored user information that a television service provider has set” wherein the user receiver, which provides television service to the viewer, is operable to “set” or establish the viewer profile (Col 29, Lines 14-21). Alternatively, messaging may be based on “stored user

Art Unit: 2614

information that a television service provider has set” in conjunction with terminal addressing information (Col 33, Lines 16-25).

Claims 15, 16, 31, and 32 are rejected wherein the “message” or advertisement may be provide via an “interactive television application provider” or from a “television service provider” (Col 34, Lines 10-15).

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 10 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alexander et al. (US Pat No. 6,177,931).

In consideration of claims 10 and 26, as aforementioned, “stored user information” is subsequently compared to “targeting criterion” in order to determine or select an advertisement message to be presented to the user (Col 32, Lines 24-27). The Alexander et al. reference discloses that the “interactive television application” may be utilized to “set a parental control” (Col 17, Lines 12-36), however, it does not explicitly disclose nor preclude the use of such information in conjunction with targeting of advertisements. Accordingly, it would have been obvious to one having ordinary skill in the art at the time of the invention to utilize such EPG interactions as further criteria such as that associated with “parental control” for the purpose of using such information in order to better target advertisements of

Art Unit: 2614

interest. For example, an indication that particular programs are restricted may be indicative of a user with children (Col 30, Lines 29-37) and as such the user may be interested in particular types of advertisements.

12. Claims 8, 9, 12, 13, 24, 25, 28 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alexander et al. (US Pat No. 6,177,931) in view of Knee et al. (US Pat No. 5,589,892)

In consideration of claims 8 and 25, the Alexander et al. reference, as aforementioned, discloses an "interactive television application" or EPG wherein the embodiment further utilizes the viewer interactions and circumstances surrounding those actions (Col 28, Lines 30-32) to generate stored "user information". This "stored user information" is subsequently compared to "targeting criteria" in order to determine or select an advertisement message to be presented to the user (Col 32, Lines 24-27). The Alexander et al. reference, however, in disclosing EPG functionality does not disclose nor preclude that the embodiment may be further operable to perform a number of EPG functions known in the art. One such function that is not disclosed nor precluded in conjunction with the Alexander et al. EPG is that related to subscribing to services associated with premium content.

The Knee et al. reference explicitly discloses an EPG application the user may "use the interactive television application to subscribe to a service based upon user input" (Col 5, Lines 16-21; Figure 36C). Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the Alexander et al. embodiment to include EPG interactions such as those associated with the "subscribing to a service" such as that associated with premium services or other packaged programming for the purpose of

Art Unit: 2614

advantageously providing a means by which the user may automatically purchase such programming (Knee et al.: Col 4, Lines 40-46). Furthermore, in light of the combined teachings, it would have been obvious to one having ordinary skill in the art at the time of the invention to utilize such EPG interactions as further criteria for the selection of advertisements in order to better target advertisements of interest. For example, a user that subscribes to HBO® is more likely to be associated with a particular demographic and would therefore be interested in viewing advertisements targeted as such.

In consideration of claims 9 and 25, the Knee et al. reference discloses that the “interactive television application” may be utilized to “set a favorite setting” (Figures 8 and 37; Col 30, Lines 35-49). Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the Alexander et al. embodiment to include EPG interactions such as the designation of a “favorite setting” for the purpose of providing a means by which a user may customize the program guide and quickly navigate between channels of interest (Knee et al.: Col 27, Line 48 – Col 28, Line 5). Furthermore, in light of the combined teachings, it would have been obvious to one having ordinary skill in the art at the time of the invention to utilize such EPG interactions as further criteria for the selection of advertisements in order to better target advertisements of interest. For example, a user that designates ESPN as a favorite channel is likely to be interested in sport related advertisements.

In consideration of claims 12, 13, 28, and 29, the Knee et al. reference discloses that the “interactive television application” may be utilized to “order a product” or “order a service” (Col 36, Line 62 – Col 38, Line 31). Accordingly, it would have been obvious to one having

Art Unit: 2614

ordinary skill in the art at the time the invention was made to modify the Alexander et al. embodiment to include EPG interactions such as those associated with the "ordering" of products and/or services for the purpose of utilizing the EPG as a new vehicle for marketing program-related products and services capable of reaching a large audience including those who would not normally tune to existing home shopping channels (Knee et al.: Col 38, Lines 32-35). Furthermore, in light of the combined teachings, it would have been obvious to one having ordinary skill in the art at the time of the invention to utilize such EPG interactions as further criteria for the selection of advertisements in order to better target advertisements of interest.

### *Conclusion*

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure as follows. Applicant is reminded that in amending in response to a rejection of claims, the patentable novelty must be clearly shown in view of the state of the art disclosed by the references cited and the objections made.

- The Reynolds et al. (WO 99/60783) reference discloses a system and method for selecting advertisements for an interactive application based on locally established criteria.
- The Zigmond et al. (US Pat No. 6,698,020) reference discloses a system and method for the intelligent insertion of video ads based on distributed criteria and local filtering.

Art Unit: 2614

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott Beliveau whose telephone number is 703-305-4907. The examiner can normally be reached on Monday-Friday from 8:30 a.m. - 6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on 703-305-4795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access

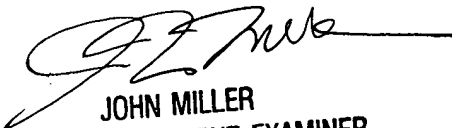
Art Unit: 2614

to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197

(toll-free).

SEB

July 22, 2004

  
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